

*Arney 10-18-4  
Serial No. 10/798,064*

### **Remarks**

#### **Request for Continued Examination**

A Request for Continued Examination (RCE) accompanies this amendment. Accordingly, pursuant to Rule 114(d), the filing of the RCE constitutes a request that the pending appeal be withdrawn and that prosecution be reopened.

#### **Amendments**

Claims 3-4, 8-21, and 29-34 are now in the case for reconsideration.

Claim 8 has been rewritten in independent form to incorporate its base claim (claim 1) and all intervening dependent claims (claims 7, 6, and 5). In addition, the limitations of claim 2 have been incorporated into claim 8.

Accordingly, claims 1-2 and 5-7 have been canceled.

New claims 29-34 have been added.

Dependent claim 29 recites "a hydrophobic layer covering said array," which is supported by hydrophobic layer 67 described in the specification at, for example, page 6, lines 18-22 and shown in FIG. 3.

Dependent claim 30 recites "said layer comprises a polymer," which is supported by layer 67 described in the specification, for example, at page 7, lines 5-8.

Dependent claim 31 recites "said hydrophobic layer comprise a material selected from the group consisting of  $CF_{1.5}$  and Teflon," which is supported by layer 67 described in the specification, for example, at page 7, lines 5-8.

Dependent claim 32 recites that the stent further includes "an electrically conductive substrate and an electrically insulative layer disposed between substrate and said hydrophobic layer, said array being formed in said substrate," which is supported by electrically conductive substrate 63, insulative layer 65, and hydrophobic layer 67 described in the specification, for example, from page 6, lines 31-32 to page 7, lines 1-4 and shown in FIG. 3.

Dependent claim 33 recites "said substrate comprises single crystal silicon and said insulative layer comprises silicon oxide," which is supported by layer 67 described in the

NOV 01 2010

Arney 10-18-4  
Serial No. 10/798,064

specification at, for example, page 7, lines 5-8.

Independent claim 34 recites a combination of features recited in various ones of claims 8-33, which are supported in the specification at, for example, pages 4-8.

It is respectfully submitted that no new matter has been added.

### **The Rathenow Reference**

In the Examiner's Answer in the aforesaid appeal, the Examiner cited Rathenow *et al.*, U.S. Patent Application Publication No. 2005/0079200 (hereinafter, **Rathenow**), in combination with other references against some of Applicants' claims. However, the Examiner did not explain his reasoning for considering Rathenow to be prior art. Applicants respectfully submit that it is not.

More specifically, the following dates are identified on the cover sheet of Rathenow:

Publication Date	April 14, 2005
U.S. Filing Date	September 10, 2004
U.S. Filing Date of PCT Parent Application	May 10, 2004

In addition, three German national applications are listed on the cover sheet of Rathenow under the heading "Foreign Application Priority Data." These German applications have filing dates between May and July 2003, which are earlier than Applicants' filing date. However, no provision of U.S. patent law has been cited by the Examiner establishing that Rathenow constitutes valid prior art as of any of these May-July 2003 foreign filing dates.

None of the U.S. publication or filing dates in 2004 precedes the March 11, 2004 filing date of the instant application. Therefore, Rathenow does not constitute valid prior art under U.S. patent law, in particular under 35 U.S.C. §102(e).

In addition, none of the German national filing dates constitutes an effective filing date of the Rathenow U.S. application. More specifically, Section 102 states "A person shall be entitled to a patent unless...

...(e) the invention was described in...(2) a patent granted on an application for patent by another filed in the United States before the invention by applicant for patent, *except* an international application filed under the treaty defined in section 351(a) [the Patent Cooperation Treaty, or PCT] shall have the effects for the purposes of this subsection of an application filed in the

*Arney 10-18-4*  
*Serial No. 10/798,064*

United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language. (emphasis added)

It is clear from the statute's cross-reference to Section 351(a) that the phrase "international application" means a PCT application, not a foreign national application. Thus, at most Rathenow might constitute prior art as of May 10, 2004, the filing date of the parent PCT application 04985 (provided that the relevant subject matter relied on by the Examiner in Rathenow is fully disclosed in the parent PCT application), but it would not constitute prior art as of any of the May-July 2003 filing dates of the three German national applications.

This conclusion is corroborated by MPEP §901.03. Also see Donner, *Patent Prosecution*, Ch. 4 II at 355 (3d ed. 2003), which discusses effective filing dates and swearing back of foreign patents as follows: "the date to be overcome under Rule 131 is the filing date of the U.S. application or international application publication under PCT Article 21(2), and *not the foreign country priority date*" (emphasis added). Clearly, therefore, foreign country priority dates (i.e., the German national application filing dates in the case of Rathenow) are not effective filing dates under U.S. patent law.

NOV 01 2010

*Arney 10-18-4  
Serial No. 10/798,064***Conclusion**

In view of the foregoing, reconsideration of claims 3-4, 8-21, and 29-34, and passage of this application to issue, are hereby respectfully requested. If during the consideration of this paper, the Examiner believes that resolution of the issues raised will be facilitated by further discussion, she is urged to contact the undersigned attorney at 610-691-7710 (voice) or 610-691-8434 (fax).

Respectfully,

Susanne Arney  
Timofei Nikita Kroupenkine  
Donald Weiss

By \_\_\_\_\_

Michael J. Urbano  
Attorney for Applicant(s)  
Reg. No. 24, 522  
610-691-7710Date: 10/31/10